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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,762	10/31/2001	Rainer Treptow	DT-6016	4302
30377	7590	08/25/2005	EXAMINER	
DAVID TOREN, ESQ. ABELMAN FRAYNE & SCHWAB 666 THIRD AVENUE NEW YORK, NY 10017-5621			HANDY, DWAYNE K	
ART UNIT		PAPER NUMBER		
		1743		

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	10/001,762	Applicant(s)	TREPTOW, RAINER
Examiner	Dwayne K. Handy	Art Unit	1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 31 May 2005.  
2a) This action is FINAL. 2b) This action is non-final.  
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 51,52,55,56,58-65 and 67 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) Claim(s) 64 and 65 is/are allowed.  
6) Claim(s) 51,52,55,56,58-63,67 is/are rejected.  
7) Claim(s) \_\_\_\_\_ is/are objected to.  
8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.  
10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. \_\_\_\_\_.  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) 5) Notice of Informal Patent Application (PTO-152)  
Paper No(s)/Mail Date \_\_\_\_\_. 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 51, 52, 55, 56, 58-63 and 67 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 51 recites an apparatus for tempering a specimen comprised of a pipette tip and syringe made of at least partially conductive material and a device for applying electric current to the conductive material. The device for applying the electric current is connected to the tip via a needle bed adapter. The Examiner believes the needle bed adapter feature lacks enablement. The disclosure contains a general teaching of the needle bed adapter on page 10, lines 1-11. This portion of the disclosure does not specify the type of container, however, instead referring to a "specimen carrier". The specific embodiment of the device that includes the needle bed adapter element is disclosed on page 12, lines 25-28. It is shown in Figure 2. In this embodiment, the **needle bed adapter is shown in use with a microtitration plate and not a pipetting device**. Applicant has not provided any written description or drawing of an embodiment of the device that has a needle bed

adapter **in conjunction with a pipette tip and syringe**. Therefore, the Examiner fails to see how one of ordinary skill in the art would be enabled to make or use the embodiment of the device comprised of a pipette tip and syringe and a device for applying the electric current that is connected to the syringe via a needle bed adapter. In claim 57, applicant has claimed a capacitive measuring sensor as part of an apparatus for tempering a specimen comprised of a pipette tip and syringe made of at least partially conductive material and a device for applying electric current to the conductive material. The capacitive measuring sensor is comprised of capacitor plates. The Examiner believes the capacitor plate feature also lacks enablement. The specific embodiment of the device that includes the capacitor plate element is disclosed on page 12, lines 13-24. It is also shown in Figure 2. In this embodiment, the **capacitor plate is shown in use with a microtitration plate and not a pipetting device**. Applicant has not provided any written description or drawing of an embodiment of the device that has a capacitor plate **in conjunction with a pipette tip and syringe**. Therefore, the Examiner fails to see how one of ordinary skill in the art would be enabled to make or use the embodiment of the device comprised of a pipette tip and syringe and a capacitive measuring sensor is comprised of capacitor plates.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 51, 52, 55, 56, 58-63 and 67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicant regards as the invention. Claim 51 recites an apparatus for tempering a specimen comprised of a pipette tip and syringe made of at least partially conductive material and a device for applying electric current to the conductive material. The device for applying the electric current is connected to the syringe via a needle bed adapter. The disclosure contains a general teaching of the needle bed adapter on page 10, lines 1-11. This portion of the disclosure does not specify the type of container, however, instead referring to a generic "specimen carrier". The specific embodiment of the device that includes the needle bed adapter element is disclosed on page 12, lines 25-28. It is shown in Figure 2. In this embodiment, the **needle bed adapter is shown in use with a microtitration plate and not a pipetting device**. Applicant has not provided any written description or drawing of an embodiment of the device that has a needle bed adapter **in conjunction with a pipette tip and syringe**. Therefore it is unclear to the Examiner as to what **structural relationship** is required between the pipette and needle bed adapter. How are these elements related in the device?

In claim 57, applicant has claimed a capacitive measuring sensor as part of an apparatus for tempering a specimen comprised of a pipette tip and syringe made of at least partially conductive material and a device for applying electric current to the conductive material. The capacitive measuring sensor is comprised of capacitor plates. The specific embodiment of the device that includes the capacitor plate element is disclosed on page 12, lines 13-24. It is also shown in Figure 2. In this embodiment, the **capacitor plate is shown in use with a microtitration plate and not a pipetting**

**device.** Applicant has not provided any written description or drawing of an embodiment of the device that has a capacitor plate **in conjunction with a pipette tip and syringe.** Therefore, it is unclear to the Examiner as to what **structural relationship** is required between the pipette tip and syringe and the capacitor plates. It appears the capacitor plates are part of the microplate when used in that embodiment, but it is unclear to the Examiner how they are related to the pipette in the claimed device.

***Allowable Subject Matter***

5. Claims 64 and 65 allowed. Claim 65 recites a method for tempering a specimen that uses conductive needles to apply the current to the specimen. This claim was misidentified as claim 64 in the previous action. Instant claim 64 recites a method for tempering a specimen consisting of applying an electric current to the specimen to resistively heat the specimen in a specimen carrier and then capacitively measuring the volume of the specimen using a capacitive measuring sensor. The sensor is comprised of capacitor plates that are formed from the same plastic based conductive material of the specimen carrier.

6. The Examiner had previously objected to claim 57 as being allowable if rewritten to include the limitations of the intervening claims. Applicant has now included these limitations in independent claim 51. The Examiner, however, failed to consider whether or not the feature from claim 57 was enabled and distinctly claimed in conjunction with

the pipette device that was added to claim 51 in the previous amendment. These considerations led to the new rejections under 112 1<sup>st</sup> and 2<sup>nd</sup> paragraphs above. The Examiner apologizes for this previous oversight. This rejection has not been made Final due to this oversight.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DKH  
August 22, 2005

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700